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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/017,654
Filing Date: December 12, 2001
Appellant(s): ANTTILA ET AL.

Phouphanamketh Ditthavong
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/14/09 appealing from the Office action mailed 4/27/09 (Advisory Action) which was in response to Final Rejection mailed 12/16/08.

(1) Real Party In Interest

The statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Liou, WO 99/46702, published internationally September 16, 1999.

Dalrymple et al., US 6,976,094 B1, issued on Dec. 13, 2005, and filed on Sep. 21, 2000.

Handley et al., RFC 2327, April 1998.

Vilander, US 7,193,987 B2.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-2, 4-6, 8-19, 23-25, 30-33 and 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liou (WO 99/46702) in view of Dalrymple et al. (hereinafter Dalrymple, US 6,976,094 B1), further in view of Handley et al. (hereinafter Handley, RFC 2327: SDP, April 1998), and further in view of Vilander (US 7,193,987 B2).

As per claim 1, Liou discloses a method comprising:

distributing a start playback request from the host terminal to the guest terminal, wherein the start playback request directs the guest terminal to being a playback session of a media file that is locally stored in the guest terminal in synchronization with a beginning of the playback session at the host terminal (fig. 10: joining and distributing play request, user 1, user 2, pg. 18 L4-32, pg. 14 L12-32: receiving messages and distributing to clients);

receiving an action request from the guest terminal requesting a playback action (fig. 10: receiving pause action from the terminal, pg. 18 L4 to pg. 19 L13: VCR commands); and

sending the playback action request received from the guest terminal to the host terminal (fig. 10: sending the pause message).

However, Liou does not expressly disclose the process of receiving a first media playback invite request initiated by a host wireless terminal, the first media playback invite request including: information sufficient to identify at least one guest wireless terminal, an identification of a pre-existing playable media file, and a playback option enabling the guest terminal to request different types of playback actions in connection with playback of the identified media file; transmitting a second media playback to the guest wireless terminal subsequent to receipt of the first media playback invite request, wherein the media playback invite request includes a playback option and the process of relaying a media playback accept response from the guest terminal to the host terminal (a typical session set up or initiation processes).

Dalrymple explicitly discloses a call set-up method during conferencing comprising the process of receiving a first media playback invite request initiated by a host terminal, the first media playback invite request including: **information sufficient** to identify at least one guest

terminal, an identification of a pre-existing playable media file (fig. 2 step 100: Invite request is send to proxy server which identifies the recipient through location server using information from the invite request message) transmitting a second media playback to the guest wireless terminal subsequent to receipt of the first media playback invite request (fig. 2 item #106) and the process of relaying a media playback accept response from the guest terminal to the host terminal (fig. 2 step #100, 106, 108, 110, fig. 4, col. 3 L50 to col. 4 L46, col. 5 L23-50: the OK response message in SIP protocol by a node/terminal is to convey to the client that the action was successfully received, understood and accepted).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Liou in view of Dalrymple in order to invite the participants or users to join a session or to engage in a session.

One of ordinary skilled in the art would have been motivated because this would have established a communication session between two computers **through invitations that invites the users to join or engage in a session** (Dalrymple: col. 3 L50 to col. 4 L18).

However, Liou in view of Dalrymple does not disclose the media playback invite request including a playback option enabling the guest terminal to request different types of actions (the feature is obvious in SIP and SDP protocols).

Handley explicitly discloses a session description protocol (SDP) including the process of sending the invitations to the users, wherein the invitations includes **various fields** comprising a playback option field **for enabling** the guest terminal to request different types of actions, i.e. enabling the receiver for interactive conferencing/meeting, i.e. for sending the

actions/data/requests (pg. 23: a= sendrecv field enables the users to send and receive data/requests/information, etc.).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Liou and Dalrymple in view of Handley in order to include a playback option in the invitation in order to enable the invited users for interactive conferences, wherein the invited users can send various types of data/requests enabled by the playback option to the host terminal.

One of ordinary skilled in the art would have been motivated because this would have enabled the receivers, i.e. users, **to engage in an interactive conference** (Handley: pg. 23).

However, LIOU, Dalrymple and Handley do not disclose the method wherein the terminals are wireless terminals.

Vilander explicitly discloses setting up communications between wireless terminals using the SIP protocols (fig. 4: MS, and col. 4 L20-38).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify LIOU, Dalrymple and Handley in view of Vilander in order to enable the wireless devices to engage in a playback session.

One of ordinary skilled in the art would have been motivated because it would enabled users to participate in a communication session using the mobile devices, See also Dalrymple: col. 3 L50 to col. 4 L21, Vilander: col. 2 L59-67, col. 4 L60-67.

As per claim 2, Liou discloses the method further comprising distributing the action request to another terminal during the playback session (pg. 6 L18-27, pg. 14 L12-33: receives action(s) and distributes to all session manager associated with the users, fig. 10).

As per claim 4, Liou discloses the method wherein the action request is selected from the group consisting of a rewind request, a pause playback request, a fast forward request, a textual comment request, and a user-specified internal effect algorithm to modify audio or video of the media file (pg. 11 L21-32, pg. 12 L12-25, fig. 4, fig. 10: pause action).

As per claim 5, Liou discloses the method comprising distributing a stop playback request from the host terminal to the guest terminal in response to the host user terminating the playback session (pg. 11 L21-32, pg. 12 L1-25: a stop button will stop the playback session, pg. 14 L12-32: distributing actions to the rest of the clients).

As per claim 6, Liou discloses the method further comprising storing an internal time in response to distributing a start playback request from the host terminal to the guest terminal, wherein the start playback request directs the guest terminal to being a playback session of a media file that is locally stored in the guest terminal in synchronization with the host terminal (pg. 7 L10-14) and providing an elapsed time since distributing the start playback request to third terminal when the third terminal joins the playback session during the playback session (pg. 6 L3-27: delaying, pg. 14 L12-24).

As per claim 8, Liou discloses the method further comprising receiving a stop playback request from the guest terminal in response to the guest user withdrawing from the playback session (pg. 11 L21-32, pg. 12 L1-25: a stop button will stop the playback session); and removing a session entry that is associated with the guest terminal, wherein the session entry indicates participation of the guest terminal in the playback session (pg. 14 L12-23: managing state of the conference).

As per claim 9, Liou discloses the method further comprising receiving a stop playback request from the host terminal in response to the host user ending the playback session and terminating the playback session in response to receiving a stop playback request (pg. 11 L21-32, pg. 12 L1-25: a stop button will stop the playback session).

As per claim 10, Liou discloses the method further comprising instructing the guest terminal to modify the media file in accordance with a modification file during the playback session (fig. 4, pg. 7 L29 to pg. 8 L6: client loads one of video and recorded annotation file in a user interface for performing annotation of the video file, i.e. annotating/modifying the media file in accordance with the recorded annotation file, pg. 12 L12-25: recording annotations in accordance with a text edit window, pg. 19 L9-13: annotate during the playback of recorded annotation file, commanding to draw annotation based on the received annotation record, i.e. a modification file).

As per claim 13, Liou discloses the computer readable medium further comprising instructions to perform distributing a stop playback request from the host terminal to the guest terminal (fig. 10).

However, Liou does not disclose distributing a stop playback request to at least one other terminal in response to host terminal user terminating the playback session.

Dalrymple discloses multiple guest terminals and//or users engaging in playback session utilizing SIP protocol (col. 4 L31-47).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Liou in view of Dalrymple in order to distribute the stop request to at least one other terminal.

One of ordinary skilled in the art would have been motivated because it would have enabled playback and/or conference session with multiple users (Dalrymple: col. 4 L31-47).

As per claim 14, Liou discloses a method comprising:

Distributing/sending a start playback request from the host terminal to the guest terminal, wherein the start playback request directs the guest terminal to being a playback session of a media file that is locally stored in the guest terminal in synchronization with a beginning of the playback session at the host terminal (fig. 10: joining and distributing play request, user 1, user 2, pg. 18 L4-32, pg. 14 L12-32: receiving messages and distributing to clients);

receiving an action request from the guest terminal, wherein the action request includes the playback option (fig. 10: receiving pause action from the terminal, pg. 18 L4 to pg. 19 L13: VCR commands); and

sending the playback option received from the guest terminal to the host terminal (fig. 10: sending the pause message).

However, Liou does not expressly disclose the process of sending a media playback invite request to at least one guess wireless terminal from a host wireless terminal, wherein the media playback invite request includes information sufficient to identify at least one guest wireless terminal, an identification of a pre-existing playable media file, and a playback option enabling the guest terminal to request different types of playback actions in connection with playback of the identified media file and the process of receiving a media playback accept response from the guest terminal to the host terminal in response to invite request (a typical session set up or initiation processes).

Dalrymple explicitly discloses a call set-up method during conferencing comprising the process of receiving a first media playback invite request initiated by a host terminal, the first media playback invite request including: information sufficient to identify at least one guest terminal, an identification of a pre-existing playable media file (fig. 2 step 100: Invite request) and the process of receiving a media playback accept response from the guest terminal to the host terminal (a typical session set up or initiation processes, fig. 2 step #100, 106, 108, 110, fig. 4, col. 3 L50 to col. 4 L46, col. 5 L23-50: the OK response message in SIP protocol by a node/terminal is to convey to the client that the action was successfully received, understood and accepted).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Liou in view of Dalrymple in order to set-up the session.

One of ordinary skilled in the art would have been motivated because this would have established a communication session between two computers through invitations (Dalrymple: col. 3 L50 to col. 4 L21).

However, Liou in view of Dalrymple does not disclose the media playback invite request including a playback option enabling the guest terminal to request different types of actions (the feature is obvious in SIP and SDP protocols).

Handley explicitly discloses a session description protocol (SDP) including the process of sending the invitations to the users, wherein the invitations includes **various fields** comprising a playback option field **for enabling** the guest terminal to request different types of actions, i.e. enabling the receiver for interactive conferencing, i.e. for sending the actions (pg. 23: a= sendrecv field enables the users to send and receive data).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Liou and Dalrymple in view of Handley in order to include a playback option in the invitation.

One of ordinary skilled in the art would have been motivated because this would have enabled the receivers, i.e. users, to engage in an interactive conference (Handley: pg. 23).

However, LIOU, Dalrymple and Handley do not disclose the method wherein the terminals are wireless terminals.

Vilander explicitly discloses setting up communications between wireless terminals using the SIP protocols (fig. 4: MS, and col. 4 L20-38).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify LIOU, Dalrymple and Handley in view of Vilander in order to enable the wireless devices to engage in a playback session.

One of ordinary skilled in the art would have been motivated because it would have provided playback session to the wireless devices.

As per claim 30, Liou discloses the method wherein the media file is locally stored on the guest terminal for playback (pg. 6 L3-10).

As per claim 43, LIOU in view of Dalrymple discloses the apparatus wherein the media playback invite request includes information sufficient to identify multiple guest wireless terminals (col. 4 L3-46).

As per claims 11-12, 15-19, 23-25, 31-33, 42 and 44-45, they do not teach or further define over the limitations in claims 1-2, 4-6, 8-10, 13, 14 and 30. Therefore, claims 11-12, 15-

19, 23-25, 31-33, 42 and 44-45 are rejected for the same reasons as set forth in claims 1-2, 4-6, 8-10, 14 and 30.

Claims 36, 39 and 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liou (WO 99/46702) in view of Dalrymple et al. (hereinafter Dalrymple, US 6,976,094 B1), further in view of Kumar et al. (hereinafter Kumar, US 6,006,253), and further in view of Vilander (US 7,193,987 B2).

As per claim 36, Liou discloses an apparatus (i.e. a host and/or guest terminal, pg. 10 L1-24, for use in a synchronous media playback system) comprising:

a processor (pg. 10 L1-24); and

memory (pg. 6 L3-10) storing computer-executable instructions that when executed (pg. 10 L1-24, fig. 1: plurality of host terminals), perform:

receiving at the apparatus a start playback request, wherein the start playback request begins a playback session of the identified media file in synchronization with a beginning of the playback session at a host terminal (fig. 10: joining and distributing play request, user 1, user 2, pg. 18 L4-32, pg. 14 L12-32: receiving messages and distributing to clients);

subsequent to receiving the start playback request, transmitting an action request to the server, wherein the action request includes the playback option (fig. 10: receiving pause action from the terminal, pg. 18 L4 to pg. 19 L13: VCR commands and sending the pause message).

However, Liou does not expressly disclose the process of receiving a media playback invitation at the apparatus from a server via a wireless channel, wherein the media playback invitation includes an identification of a pre-existing playable media file, a playback option

enabling the apparatus to request different types of playback actions in connection with playback of the identified media file and responsive to receiving the media playback invitation, transmitting a media playback accept response to the server, wherein if the apparatus does not have the media file, the apparatus downloads the media file before transmitting the media playback accept response.

Dalrymple explicitly discloses a call set-up method during conferencing comprising the process of sending an invite request message from the host terminal to the guest terminal through a central server, i.e. receiving at the apparatus an invitation from the server, wherein the invitation includes an identification of a pre-existing playable media file (SIP uses SDP to describe the session including identification of media file) and responsive to receiving the media playback invitation, transmitting a media playback accept response to the server (i.e. a standard approach for setting up a communication session and sending invitations in SIP protocol, fig. 2 step #100, 106, 108, 110, fig. 4, col. 3 L50 to col. 4 L46, col. 5 L23-50: the OK response message in SIP protocol by a node/terminal is to convey to the client that the action was successfully received, understood and accepted).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Liou in view of Dalrymple in order to invite the users and receive the response.

One of ordinary skilled in the art would have been motivated because this would have established a communication session between two computers through invitations (Dalrymple: col. 3 L50 to col. 4 L21).

However, Liou in view of Dalrymple does not disclose the media playback invite request including a playback option enabling the guest terminal to request different types of actions and the process wherein if the apparatus does not have the media file, the apparatus downloads the media file before transmitting the media playback accept response.

Kumar discloses the SDP comprising sending an announcement, i.e. invitations, including a playback option, i.e. field for indicating mode of operation such as sendonly, sendrecv or recvonly, enabling the guest terminal to request different types of actions i.e. enabling the receiver for interactive conferencing, i.e. for sending the actions (fig. 6 item #650, col. 10 L11-44), and the process of downloading the media file if the apparatus does not have the media file (col. 7 L25-55: note that the invitations and/or announcement enables the user to download the slides before and/or after the user transmits the accept response).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Liou and Dalrymple in view of Kumar in order to include a playback option in the invitation and download the media filed before transmitting the accept message.

One of ordinary skilled in the art would have been motivated because this would have enabled the receivers, i.e. users, to engage in an interactive conference regarding the media file (See claim 1).

However, LIOU, Dalrymple and Handley do not disclose the process of receiving a media playback invitation at the apparatus from a server via a wireless channel.

Vilander explicitly discloses the process of receiving a media playback invitation at the apparatus from a server via a wireless channel (fig. 4: MS, and col. 3 L65 to col. 4 L38).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify LIOU, Dalrymple and Handley in view of Vilander in order to receive the invitation from the server via the wireless channel.

One of ordinary skilled in the art would have been motivated because it would enabled users to participate in a communication session using the mobile devices, See also Dalrymple: col. 3 L50 to col. 4 L21, Vilander: col. 2 L59-67, col. 4 L60-67.

As per claim 38, Liou and Dalrymple discloses the apparatus wherein the processor utilizes the communication interface to communicate to a central server, wherein the central server receives and forwards invitations and responses between the apparatus and the terminal (Liou: pg. 10 L1-24, pg. 14 L12-32, fig. 1, fig. 10; Dalrymple: fig. 2-4, pg. 16 L21-27).

As per claim 39, Liou discloses the apparatus wherein the processor includes instructions to perform modifying the media file in accordance with a modification file during the playback session (fig. 4, pg. 7 L29 to pg. 8 L32: client loads one of video and/or recorded annotation file in a user interface for changing the speed and/or performing annotation of the video file, i.e. annotating/modifying the media file in accordance with the recorded annotation file, pg. 11 L21-32, pg. 12 L12-25: recording annotations in accordance with a text edit window, pg. 19 L9-13: annotate during the playback of recorded annotation file, commanding to draw annotation based on the received annotation record, i.e. a modification file).

As per claims 46-47, they do not teach or further define over the limitations in claims 36 and 39. Therefore claims 46-47 are rejected for the same reasons as set forth in claims 36 and 39.

Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liou (WO 99/46702) in view of Dalrymple et al. (hereinafter Dalrymple, US 6,976,094 B1), and further in view of Handley et al. (hereinafter Handley, RFC 2327: SDP, April 1998), further in view of Vilander (US 7,193,987 B2), and further in view of Kumar et al. (hereinafter Kumar, US 6,006,253).

As per claim 40, Liou, Dalrymple, Handley and Vilander discloses the method as in claim 1 as set forth above.

However, Liou, Dalrymple, Handley and Vilander do not disclose the method wherein if the guest terminal does not have the media file, the guest terminal downloads the media file before sending the media playback accept response.

Kumar discloses the process of downloading the media file if the apparatus does not have the media file (col. 7 L25-55: note that the invitations and/or announcement enables the user to download the slides before and/or after the user transmits the accept response).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Liou, Dalrymple, Handley and Vilander in view of Kumar in order to download the media filed before transmitting the accept message.

One of ordinary skilled in the art would have been motivated because it would have enabled the receivers, i.e. users, to engage in an interactive conference regarding the media file.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liou (WO 99/46702) in view of Dalrymple et al. (hereinafter Dalrymple, US 6,976,094 B1), in view of Handley et al. (hereinafter Handley, RFC 2327: SDP, April 1998), further in view of Vilander

(US 7,193,987 B2), and further in view of Crandall et al. (hereinafter Crandall, US 2002/0107040 A1).

As per claim 7, Liou, Dalrymple, Handley and Vilander discloses the process of receiving a host internal time from the host terminal or the guest terminal, wherein the host internal time is derived from a global time (Liou: pg. 6 L3-27, pg. 14 L12-24, pg. 7 L10-14).

However, Liou, Dalrymple, Handley and Vilander do not expressly disclose the process of comparing the host internal time to a guest internal time in order to derive a time difference, wherein the guest internal time is derived from the global time; and adjusting transmission of a subsequent message to the host terminal or the guest terminal (Liou may inherently teach the process).

Crandall discloses the process of synchronizing messages by determining host time and guest time, comparing the host time with the guest time in order to derive time difference, i.e. delay, and adjusting the transmission of a subsequent message to the host terminal (fig. 4, fig. 5, fig. 7, fig. 9, pg. 2 [0030-0034], pg. 3 [0044-0046], pg. 4 [0047-0057]).

Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Liou, Dalrymple, Handley and Vialnder in view of Crandall in order to derive a time difference and adjust the transmission of the messages.

One of ordinary skilled in the art would have been motivated because it would have provided same amount of latency for different users and/or actions (Crandall, pg. 1 [0005]).

Claims 3 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liou (WO 99/46702) in view of Dalrymple et al. (hereinafter Dalrymple, US 6,976,094 B1), in view

of Handley et al. (hereinafter Handley, RFC 2327: SDP, April 1998), further in view of Vilander (US 7,193,987 B2), and further in view of Agresta et al. (hereinafter Agresta, US 2002/0091848 A1).

As per claim 3, Liou, Dalrymple, Handley and Vilander do not disclose the process of verifying permissions associated with the guest terminal, wherein the sending of the playback option received from the guest terminal to the host terminal is responsive to verifying the permissions associated with the guest terminal.

Agresta explicitly teaches the process of verifying the permissions, i.e. authoring account before executing the process such as pause, rewind, forward, etc. (fig. 4A step #116, 138, pg. 6 [0051]).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Liou, Dalrymple, Handley and Vilander in view of Agresta in order to verify the permissions of the terminals and/or users before executing any actions.

One of ordinary skilled in the art would have been motivated because it would have verified the access rights of the user.

As per claim 41, it does not teach or further define over the limitations in claims 3 and 20. Therefore, claim 41 is rejected for the same reasons as set forth in claims 3 and 20.

(10) Response to Argument

In the Appeal Brief (hereinafter, The Brief), appellant has raised various arguments. The Examiner summarizes and addresses each of the argument individually.

In the Brief, appellant argues in substance that:

a. Appellants argue the rejection of claims 1-19, 23-25, 30-33, 36 and 39-47 under 35 USC 112, first paragraph (The Brief, pg. 14 VII. A.).

In response to argument [a], the rejection is withdrawn in view of claim amendments made after final action, which were entered in the advisory action 4/27/09.

b. None of the references provides for a "media playback invite request including a playback option enabling the guest wireless terminal to request different types of **playback options** in connection with playback of the identified media file" (The Brief, pg. 16, B.).

In response to argument [b], Examiner respectfully disagrees.

Initially, It should be noted that "a playback option…**playback options** in connection…" is not recited in the rejected claim.

However, It appears that appellant intended to recite "media playback option enabling…**playback actions** in connection…"

Independent claim 1, which was amended after final rejection and entered, recites:

A method comprising:
receiving a first media playback invite request initiated by a host wireless terminal, the first media playback invite request including
information sufficient to identify at least one guest wireless terminal,
an identification of a pre-existing playable media file, and

a playback option enabling the guest wireless terminal to request different types of playback actions in connection with playback of the identified media file;

transmitting a second media playback invite request to the guest wireless terminal subsequent to receipt of the first media playback invite request, wherein the second media playback invite request includes the playback option;

relaying a media playback accept response from the guest wireless terminal to the host wireless terminal;

distributing a start playback request from the host wireless terminal to the guest wireless terminal, wherein the start playback request directs the guest wireless terminal to begin a playback session of the identified media file in synchronization with a beginning of the playback session at the host wireless terminal;

receiving an action request from the guest wireless terminal,-requesting a playback action enabled by the playback option; and

sending the action request received from the guest wireless terminal to the host wireless terminal.

In the Brief, appellant argues that none of the references disclose or suggest the single invite request that includes "information sufficient to identify the at least one guest wireless terminal, an identification of a pre-existing playable media file, and a playback option enabling the guest terminal to request different types of playback actions in connection with playback of the identified media file", e.g. pg. 17, 2nd paragraph.

In support for the above recitations, **appellant specification discloses:**

[25] As was discussed in relation to FIG. 1, the host user initiates a playback session by causing terminal 101 to send invite request 201 to messaging server 109. In one variation, invite request 201 comprises various information fields, including guest user ID, session ID**, media file ID**, host user ID, playback options, playback scheduling, and a flee text string of other media type that explains the invitation to the guest users. **Playback options give specific guest users permission to request different types of actions during the playback session**. Table 1 shows information that is contained in the invite request in accordance with the exemplary embodiment. With this example, a GSM SMS message is able to transport 160 characters of text. (Alternatively, a Multimedia Messaging System (MMS) message can be utilized for supporting synchronous media and playback messaging.) In the example, the SMS message is represented as:…

[31] **During the playback session (as initiated by start playback requests 221 and 223), any of the active users (host user and guest users) can request a playback action. In order to do so, an active user sends an action request (e.g. action request 225) to central server 107. The action request message requests one of a number of action types during the playback session, including pause playback, rewind, fast-forward, user- specified internal effect algorithm to modify audio or video (e.g. altering the audio and video in order to accentuate a favorite actress), or textual comment from a user. The first three action types are patterned after actions that are typically associated with an audio cassette player or a VCR. The fourth action type is user-specified that can be customized for the specific application. As an example, the media player can be instructed to emphasize the dialog of a particular actress in a particular scene. As another example, if a user wishes to send a comment to the other users, an action request message with textual comment (e.g. "I really like this scene - Jane") is sent to central server 107.**

First, it is noted that the playback option enabling the user to request different types of playback actions comprises **requesting one of a number of action types during the playback session, including pause playback, rewind, fast-forward, user- specified internal effect algorithm to modify audio or video (e.g. altering the audio and video in order to accentuate a favorite actress), or textual comment from a user. As an example: appellant discloses that "if a user wishes to send a comment to the other users, an action request message with textual comment e.g. I really like this scene…is sent to the central server.**

Stated another way, one of the playback action may comprise inputting and/or sending the textual comment from a user, i.e. inputting and sending the data such as text comment from a user.

PRIOR ART

Initially, **Liou discloses** the process of joining a session, distributing a start playback request from the host terminal to the guest terminal, receiving an action request such as a pause action, from the guest terminal, and sending the action such as the pause action from the guest terminal to the host terminal, See fig. 10.

However, Liou does not disclose the process of sending an invite message to the guest terminal including the sufficient information, the identification and the playback option enabling the guest terminal to request different types of playback actions.

But, these functionalities and/or processes, i.e. sending the first and second invitations including the sufficient information, the identification and the playback option

enabling the guest terminal to request different types of playback options are typical processes of a SIP protocol.

A SIP protocol is an application-layer control protocol for creating, modifying and terminating sessions with one or more participants, See RFC 2543, which is incorporated by reference in Dalrymple, e.g. col. 3 L51-60.

Moreover, Dalrymple explicitly discloses the **usage of SIP protocol** for inviting the other computers to begin a playback session of a media file in synchronization, e.g. fig. 2 and col. col. 3 L50 to col. 4 L46, which are reproduced herein.

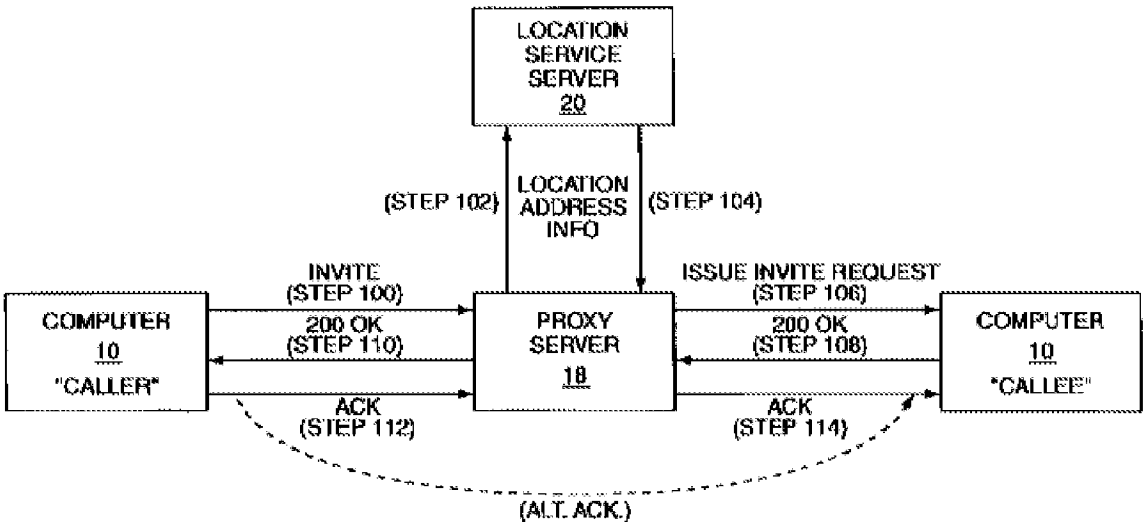

FIG. 2

Preferably, each WBID **16** has the ability to establish a session with other WBIDs **16** over a data network transport of any type. There are numerous protocols for establishing these types of sessions and any of them are sufficient as long as they are capable of communicating information from one user to another according to the concepts described herein. The preferred embodiment of the invention uses the session initiation protocol (SIP) as described in the Internet Engineering Task Force's (IETF) RFC2543, which is incorporated herein by reference in its entirety.

The WBID may establish sessions using any number of techniques as will be apparent to those of ordinary skill in the art. With respect to the present invention, it is important that once a session is established, URL information or like web page location indicia can be passed between the WBIDs **16** of the various computers **10** engaged in a session. Prior to describing the details of web synchronization, two exem-

plary techniques for establishing sessions between computers **10** using SIP are provided.

Establishing a session between two computers **10** using SIP requires an SIP invitation consisting of two requests, an INVITE request followed by an acknowledgment (ACK) message. The INVITE request asks a "callee" to join or engage in a session with a "caller." The session may be a conference with multiple users or a simple, two-party session. After the callee agrees to participate in a call, the caller confirms that it has received response by sending the ACK message. When the caller desires to end the session, a BYE request is sent to the callee.

The INVITE request will typically contain a session description providing the callee with sufficient information to join the session. For multi-cast sessions, such as those used in conferencing, the session description defines the media types and formats that may be used or otherwise distributed in the session.

The protocol for session initiation using SIP is shown in FIG. **2** for a proxy server and FIG. **3** for a redirect server. In FIG. **2**, a proxy server **18** accepts the INVITE request from a caller computer **10** (step **100**) and contacts a location service server **20** with all or part of the caller's address to determine specific address information for the invited callee computer **10** (step **102**). The location service server **20** will process the information and return a specific address identifying the callee computer **10** to the proxy server **18** (step **104**). The proxy server **18** will then issue an INVITE request to the callee computer **10** based on the specific address returned by the location service server **20** (step **106**).

Notably, for a conference session where there are multiple callees, the proxy server **18** will send INVITES to each of the callee computers **10** based on addresses received from the location service server **20** as necessary. A user agent server running on the callee computer **10** will alert the callee that a session is being requested, and if the session is accepted by the callee, return a success indication (**200** OK) to the proxy server **18** (step **108**). The proxy server **18** will relay the indication to the caller computer **10** (step **110**). Receipt of this indication by the caller computer **10** will result in sending an ACK message to the proxy server **18** (step **112**), which will forward the ACK message to callee computer **10** (step **114**). Alternatively, the ACK message may be sent directly to the callee computer **10**. Throughout the session, the request and responses will typically have the same session or call identification.

Stated another way, Dalrymple uses the SIP protocol to invite the other participants to join a session or engage in a session by sending an invitation, i.e. the INVITE request and receiving an acknowledgement from the invited participants.

The Invite request comprises information sufficient to identify at least one invited guest terminal.

For example: A proxy server accepts the invite request from a caller computer and contacts a location service server **with all or part of the caller's address to determine specific address information for the invited callee**, e.g. Dalrymple: col. 4 L20-31, which is reproduced above, See RFC 2543: SIP protocol, pg. 14 [1.4.4], which is also reproduced below.

In other words, the invite request provides sufficient information to identify at least one guest or invited terminal because the proxy server is capable of identifying the recipient's address.

Although, Dalrymple does not explicitly recite the usage of session description protocol, i.e. SDP, the SIP protocol implicitly and/or inherently uses the session description protocol, i.e. SDP, to describe a session.

For example: See RFC 2543: SIP protocol, Pg. 14 [1.4.4]: SIP Invitation, which is reproduced herein.

> 1.4.4 SIP Invitation
>
> A successful SIP invitation consists of two requests, INVITE followed by ACK. The INVITE (Section 4.2.1) request asks the callee to join a particular conference or establish a two-party conversation. After the callee has agreed to participate in the call, the caller confirms that it has received that response by sending an ACK (Section 4.2.2) request. If the caller no longer wants to participate in the call, it sends a BYE request instead of an ACK.
>
> **The INVITE request typically contains a session description, for example written in SDP (RFC 2327 [6]) format, that provides the called party with enough information to join the session…**
>
> The protocol exchanges for the INVITE method are shown in Fig. 1 for a proxy server and in Fig. 2 for a redirect server. (Note that the messages shown in the figures have been abbreviated slightly.) In Fig. i, the proxy server accepts the INVITE request (step i), contacts the location service with all or parts of the address (step 2) and obtains a more precise location (step 3). The proxy server then issues a SIP INVITE request to the address(es) returned by the location service (step 4). The user agent server alerts the user (step 5) and returns a success indication to the proxy server (step…

The SIP invite request typically contains a session description, **written in SDP** (RFC 2327) format that provides the called party **enough information to join the session**, e.g. See RFC 2543, pg. 14 [1.4.4], which is reproduced above.

More specifically, the SDP provides the following information to the callee and/or in an Invite message:

- Session name and purpose
- Time the session is active
- The media comprising the session
- Information to receive those media, etc.

A session description consists of a session-level description and **optionally** several media level descriptions, **wherein the media description includes media name, title, etc**., See RFC 2327 or Handley, [5], [5.1], [6]: SDP specification, reproduced herein.

"…A session description consists of a session-level description (details that apply to the whole session and all media streams) and optionally several media-level descriptions (details that apply onto to a single media stream).

An announcement consists of a session-level section followed by zero or more media-level sections. The session-level part starts with a "v:' line and continues to the first media-level section. The media description starts with an "m:' line and continues to the next media description or end of the whole session description. In general, session-level values are the default for all media unless overridden by an equivalent media-level value.

When SDP is conveyed by SAP, only one session description is allowed per packet. When SDP is conveyed by other means, many SDP session descriptions may be concatenated together (the "v:' line indicating the start of a session description terminates the previous description). Some lines in each description are required and some are optional but all must appear in exactly the order given here (the fixed order greatly enhances error detection and allows for a simple parser). **Optional items are marked with a '"*'**

Session description

v= (protocol version)
o= (owner/creator and session identifier).
s: (session name)
i=* (session information)

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u=* (URI of description)

e=* (email address)

p=* (phone number)

c:* (connection information - not required if included in all media)
b=* (bandwidth information)

One or more time descriptions (see below)

z:* (time zone adjustments)

k=* (encryption key)

a=* (zero or more session attribute lines)

Zero or more media descriptions (see below)

Time description

t: (time the session is active)

r=* (zero or more repeat times)

Media description

m= (media name and transport address)
i=* (media title)
c:* (connection information - optional if included at session-level)
b=* (bandwidth information)
k=* (encryption key)
a=* (zero or more media attribute lines)

Stated another way, the SIP Invite request comprises identification of a pre-existing playable media file, i.e. media name and/or media title as set forth above, through SDP descriptions.

In the Brief, e.g. pg. 17, appellant argues that "the combination fails to teach or suggest an invite request that includes the claimed "playback option enabling the guest terminal to request different types of playback actions in connection with playback of the identified media file"…However, careful review of Handley et al. reveals that the "a=sendrecv" field described at page 22 is not a playback option enabling the guest wireless terminal to request different types of playback actions in connection with playback of a pre-existing playable media file. **Rather, the "a=sendrecv" instruction merely specifies that tools should be started in a "send and receive mode".**

In response to argument above, Examiner respectfully disagrees.

Independent claim 1, in part, recites:

A method comprising:
receiving a first media playback invite request initiated by a host wireless terminal, the first media playback invite request including
information sufficient to identify at least one guest wireless terminal,
an identification of a pre-existing playable media file, and
a playback option enabling the guest wireless terminal to request different types of playback actions in connection with playback of the identified media file

Claim Interpretation

The limitation recites "the invite request…including a playback option **enabling** the guest terminal **to** request different types of playback actions…"

The term "enabling" and/or "enable" is defined as a command or condition that permits some specific event to occur, or a command or condition that permits some specific event to proceed, See The Authoritative Dictionary of IEEE Standards Terms, Seventh Edition, pg. 378.

In view of this definition, the recitation suggests that the playback option allows/permits the guest terminal to request different types of action requests.

Note that as per appellant's specification, which is reproduced above, the playback option enabling the user to request different types of playback actions comprises **requesting one of a number of action types during the playback session, including pause playback, rewind, fast-forward, user- specified internal effect algorithm to modify audio or video (e.g. altering the audio and video in order to accentuate a favorite actress), or textual comment from a user. As an example: appellant discloses that "if a user wishes to send a comment to the other users, an action request message with textual comment e.g. I really like this scene…is sent to the central server.**

In RFC 2327, Handley discloses an example SDP description, e.g. pg. 7-8:

v=0

o=mhandley 2890844526 2890842807 IN IP4 126.16.64.4
s=SDP Seminar
i:A Seminar on the session description protocol
u=http://www.cs.ucl.ac.uk/staff/M.Handley/sdp.03.ps
e=mjh@isi.edu (Mark Handley)
c=IN IP4 224.2.17.12/127

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t=2873397496 2873404696
a=recvonly
m:audio 49170 RTP/AVP 0
m:video 51372 RTP/AVP 31
m:application 32416 udp wb
a:orient:portrait

Handley, at pg. 17-18, further discloses:

Attributes

a=

a=:

Attributes are the primary means for extending SDP. Attributes may be defined to be used as "session-level" attributes, "media-level" attributes, or both.

A media description may have any number of **attributes ("a:" fields) which are media specific.** These are referred to as "media-level" attributes and add information about the media stream. Attribute fields can also be added before the first media field; these "session-level" attributes convey additional information that applies to the conference as a whole rather than to individual media; an example might be the conference's floor control policy.

Attribute fields may be of two forms:

o property attributes. A property attribute is simply of the form "a:". These are binary attributes, and the presence of the attribute conveys that the attribute is a property of the session. An example might be **"a:recvonly".**

o value attributes. A value attribute is of the form "a::". An example might be that a whiteboard could have the value attribute "a:orient:landscape"

Attribute interpretation depends on the media tool being invoked. Thus receivers of session descriptions should be configurable in their interpretation of announcements in general and of attributes in particular.

And, at pg. 22-23, Handley further discloses:

a=recvonly

This specifies **that the tools should be started in receive-only** mode where applicable. It can be either a session or media attribute, and is not dependent on charset.

a:sendrecv

This specifies **that the tools should be started in send and receive mode. This is necessary for interactive conferences with tools such as wb which defaults to receive only mode. It can be either a session or media attribute**, and is not dependent on charset.

a:sendonly

This specifies that **the tools should be started in send-only** mode. An example may be where a different unicast address is to

be used for a traffic destination than for a traffic source. In such a case, two media descriptions may be use, one sendonly and one recvonly. It can be either a session or media attribute, but would normally only be used as a media attribute, and is not dependent on charset.

a:orient:

Normally this is only used in a whiteboard media specification. It specifies the orientation of a the whiteboard on the screen. It is a media attribute. Permitted values are "portrait', "landscape' and "seascape' (upside down landscape). It is not dependent on charset

Clearly, the "a=recvonly", "a=sendrecv" and "a=sendonly" options enables/allows/permits and/or disables/disallows the guest terminal to send data/command/instructions enabled by the "a=xxxx" option.

Clearly, the "a" attribute **option**, **which is also media specific**, i.e. is in connection with playback of a pre-existing playable media file, is included within the SDP description in the invite message.

In an event the tools are started in sendonly mode, the host terminal may not allow the guest terminal to send any data/requests/instructions such as comments, requests, etc.

For example: the guest terminal may not be able/allowed/permitted to send any data, i.e. a request for sending data in connection, i.e. with respect to the media file, i.e. a type of action in connection with the media file in playback session, such as inputting a comment and attempting to send the comment about a media file.

In an event the tools are started in "sendrecv" mode, the host terminal allows the guest terminal to send the data, wherein if the guest terminal can send data **implies** that the guest terminal can send any requests and/or instruction with respect to comments.

For example: a:sendrecv

This specifies that the tools should be started in send and receive mode. **This is necessary for interactive conferences with tools such as wb which defaults to receive only mode. It can be either a session or media attribute**, and is not dependent on charset.

This option enables the computers to send and receive data and/or information. In other words, it enables the callee computer to send the different types of actions associated with a tool, such as wb for interactive conferences. (Note that appellant specification suggests the action request to include inputting a comment and sending the comment, i.e. data).

The term "interaction" means both the host and guest can participates in a session collaboratively. In Other words, both the host and guest can send data, request, comments, actions, instructions, etc.

For example: If a host and guest are engaged in an online meeting or collaboration, e.g. Handley, pg. 23. In this case, the "sendrecv" only mode enables the guest terminal to send data with respect to or in connection to media file such as slides, etc., wherein the data may comprise questions, answers, comments, actions, requests, etc., which are typical processes in a meeting. (Note that appellant specification suggests the action request to include inputting a comment and sending the comment, i.e. data).

Moreover, In the written description, e.g. pg. 7 [25], applicant discloses:

"…In one variation, invite request comprises various fields, including guest user id, session id, media file id, host user id, playback options, playback scheduling, and a free text string of other media type that explains the invitation to the guest users. **Playback options give specific guest users permission to request different types of actions during playback session**…"

In other words, the playback option may allow/disallow the guest users to request different types of actions.

The "a=sendrecv" field in Handley is a playback option that is associated with the playback and/or synchronization of media and is a media specific, **which enables and/or allows** the callee computer to send and receive data including requesting different types of actions. One of the "a=…" field denies the guest users to request different types of actions, i.e. denies the users to send any data or requests.

Furthermore, appellant acknowledges that "Instead, Handley indicates that…should be started in "send and receive mode", e.g. The Brief, pg. 18.

The send and receive mode enables and/or gives the callee the permissions to receive and send the data. The data can include requesting different types of action/requests such as inputting a comment in connection to or regarding a media file.

In fact, appellant specification also suggests conveying the playback option as a mode, e.g. specification, pg. 8-9 [26].

Furthermore, the claim recites "…a playback option enabling the guest wireless terminal **to request different types of playback actions in connection**…".

It appears that the recitation "to request different types of…" is a latent property or an additional advantage which would flow naturally from following the suggestion of the prior art. For example: if the guest terminal cannot send data **implies** that the guest terminal cannot send any requests and/or instructions.

Mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. In re Wiseman, 596 F.2d 1019, 201 USPQ 658 (CCPA1979) (Claims were directed to grooved carbon disc brakes wherein the grooves were provided to vent steam or vapor during a braking action. A prior art reference taught noncarbon disc brakes which were grooved for the purpose of cooling the faces of the braking members and eliminating dust. The court held the prior art references when combined would overcome the problems of dust and

overheating solved by the prior art and would inherently overcome the steam or vapor cause of the problem relied upon for patentability by applicants. Granting a patent on the discovery of an unknown but inherent function (here venting steam or vapor) "would re-move from the public that which is in the public domain by virtue of its inclusion in, or obviousness from, the prior art." 596 F.2d at 1022, 201 USPQ at 661.); In re Baxter Travenol Labs., 952 F.2d 388, 21 USPQ2d 1281 (Fed. Cir. 1991) (Appellant argued that the presence of DEHP as the plasticizer in a blood collection bag unexpectedly suppressed hemolysis and therefore rebutted any prima facie showing of obviousness, however the closest prior art utilizing a DEHP plasticized blood collection bag inherently achieved same result, although this fact was unknown in the prior art.).

"The fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious." Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985) (The prior art taught combustion fluid analyzers which used labyrinth heaters to maintain the samples at a uniform temperature. Although appellant showed an unexpectedly shorter response time was obtained when a labyrinth heater was employed, the Board held this advantage would flow naturally from following the suggestion of the prior art.). See also Lantech Inc. v. Kaufman Co. of Ohio Inc., 878 F.2d 1446, 12 USPQ2d 1076, 1077 (Fed. Cir. 1989), cert. denied, 493 U.S. 1058 (1990) (unpublished — not citable as precedent) ("The recitation of an additional advantage associated with doing what the prior art suggests does not lend patentability to an otherwise unpatentable invention.").

In re Lintner, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) and In re Dillon, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990) discussed in MPEP § 2144 are also pertinent to this issue. See MPEP 2145 II.

In the Brief, e.g. pg. 18, appellant asserts "However, the Examiner points to no evidence that Handley et al. relate to playback of a pre-existing playable media file".

First, Liou clearly discloses playback of a pre-existing playable media file, e.g. fig. 10 and pg. 18 line 4 to pg. 19 line 13.

Secondly, Dalrymple discloses using a SIP protocol to invite participants to join a session and/or engage in a session, See fig. 2.

As set forth above, the SIP protocol uses SDP to provide session descriptions. **The SDP set forth above identifies the media file. Obviously, the media file is pre-existing at certain location.**

In the Brief, e.g. pg. 19, appellant asserts that "While the claim recitation of...may not require the pre-existing playable media file to be specifically at the guest wireless terminal, it is clear that when this portion...the pre-existing media file must be at the guest wireless terminal. The whole point of invite request and the acceptance of the invite request is to determine if the

guest wishes to accept the invitation and, if so, does the media file exist at the guest wireless terminal. If the media file does not exist at that location, then the guest terminal will request download of that media file before acceptance of the invite request…"

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the file must be at the guest wireless terminal…") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellant implies that when the above information portion of the claim is read in totality with other portions of the claim, e.g. "relaying a media playback accept response..." the pre-existing media file must be at the guest wireless terminal..."

In a similar way, when the combinations of references are read together, the pre-existing media file must be located at the guest terminal. In any event, Liou clearly teaches that the pre-existing media file is located at the guest terminal, See Liou, fig. 10 and pg. 18 line 4 to pg. 19 line 13.

Furthermore, appellant alleges that "the whole point of invite request and the acceptance of the invite request is to determine if the guest wishes to accept the invitation and, if so, does the media file exist at the guest terminal..."

First, both the specification and/or claims fail to teach and/or suggest applicant's point.

Secondly, the whole point of invite request is to enable the host terminals to invite the participants and enable the participants to join or engage in a session, See RFC 2543: SIP protocol, pg. 14 [1.4.4].

Appellant also asserts that "if the pre-existing media file was not, or did not need to be, at the guest terminal, there would be no need for distributing a start playback request from the host wireless terminal to the guest terminal, wherein the start playback request directs the guest wireless terminal to begin a playback session of the identified media file in synchronization with a beginning of the playback session at the host wireless terminal".e.g. The Brief, pg. 20.

Examiner, in a similar manner, points out that if the pre-existing media file was not, or did not need to be at the user 1 or user 2 of Liou, there would be no need for distributing a start playback request directing the one of the terminal to begin a playback session of the identified

media file in synchronization with a beginning of the playback session at the host terminal. See Liou, fig. 10.

Moreover, it appears that applicant is addressing the *prima facie case of obviousness* [based on the combination of references] by attacking the references individually. MPEP 2145 (IV) dearly sets forth: One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

For example: Appellant is ignoring and/or disregarding the teachings of Liou and Dalrymple, and attacks the Handley reference for pre-existing media file when Liou and Dalrymple clearly discloses pre-existence of the media file.

As such, it is believed that the combination of references discloses each and every limitation of claim 1, and a proper prima facie case of obviousness has been established.

c. None of the applied references provides for a media playback invite request including playback option enabling the guest terminal to request different types of playback actions in connection with playback of the identified media file (The Brief, pg. 20-21 C.).

In response to argument [c], Examiner respectfully disagrees for the same reasons as set forth above.

Stated another way, Kumar discloses the session description protocol in sending an announcement including playback option such as sendrecv, e.g. fig. 6 item #650 and col. 10 L11-44.

This sendrecv option is equivalent to the sendrecv option set forth above with respect to Handley, thus, the response set forth above applies here as well.

As per "pre-existing playable media file", Liou in view of Dalrymple discloses sending an invitation request message wherein the invitation includes session description including an identification of a pre-existing media file, e.g. Dalrymple: fig. 2: SIP Invite request message, Wherein SIP uses SDP for session description and SDP includes the media file name and title as set forth above.

d. Additionally, even if the Honorable Board deems independent claim 36...claim 39 is separately patentable. Claim 39 recites "modifying the identified media file in accordance with a modification file during the playback session" (The Brief, pg. 22: 3rd paragraph).

In response to argument [d], Examiner respectfully disagrees.

Dependent claim 39 recites:

> The apparatus of claim 36, wherein the processor includes executable instructions to perform: modifying the identified media file in accordance with a modification file during the playback session.

Appellant's specification discloses:

> [42] It is assumed that terminals 101,103, and 105 can fully utilize the selected media file. However, this may not be the case. With a plurality of terminals participating in the playback session, the terminals may have different capabilities. For example, the playback session may be processing a movie having both audio and video components. One of terminals (e.g. terminal 105) may have only audio capability while terminals 103 and 103 have both audio and video capabilities. **Moreover, the active users in the playback session may desire to modify the media file in order to accentuate the viewing experience.**
> **[43] According to one embodiment, the playback device associated with each of terminals 101, 103, and 105 is able to modify media characteristics, using a preset selection of effects and modifications (e.g. converting color imagery into black and white, inverting the colors, distorting the sound channels, changing the tempo and speed of the playback) stored at the terminal. In other words, a playback device utilizes a data file containing associated modifications in order to alter the processing of the media file during the playback session.**
> **[46]…modification file…modification functions…**

As one example, the appellant's specification discloses changing the speed of the playback during a playback session of the media file in accordance with a data file, i.e. data file contains the modifications or functions, e.g. instructions or commands for changing the speed, etc.

Liou explicitly discloses changing the video play speed during a playback session of a video content, e.g. col. 8 L7-32, fig. 4: video player including modification file such as

annotation control file having annotation functions, attached tools, frame rate file having frame rate control functionality, etc.

As such, Liou discloses modifying the identified media file, i.e. media file in playback session such as video content, in accordance with a modification file, i.e. a file that provides modifications. A user through the interface providing various tools can change the speed and annotate the video, e.g. pg. 11 lines 21-32, which shows changing the speed through the interface and/or modification file, pg. 12 line 13-25: user typing the text string on the video frame through a pop up text edit window, etc.

e. No adequate rationale for making the various combinations has been established (The Brief, pg. 24 E.). The Examiner has not provided an adequate motivation for combining the references (pg. 25).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In the Brief, e.g. pg. 25, appellant asserts that "For example...the examiner asserts that it would have been obvious...(Final office action - page 15). However, Liou et al already sets up a collaborative session, so there would have been nothing to suggest to the…"

The motivation in the final office action - page 15 is:

One of ordinary skilled in the art would have been motivated because this would have established a communication session between two computers **through invitations** (Dalrymple: col. 3 L50 to col. 4 L18).

Stated another way, **the invitations invites the users to join or engage in a session** (Dalrymple: col. 3 L50 to col. 4 L18).

Appellant also asserts that "The examiner…however nothing in the prior art suggests that any playback option would be desirable in the system of Liou et al."

The playback option, i.e. an attribute a:recvonly, a:sendonly, a:sendrecv explicitly enables the tools to be started in receive only mode, where the user is limited/restricted to receive only mode; send only mode, where the user is limited/restricted to send only mode; and send/receive mode, where the users can send and receive data for interactive communications, See Handley pg 23.

This option enables the host to control the communications. For example: If the host wants to interactively communicate with the participants, the host can enable interactive communications through a:sendrecv mode.

Appellant further asserts that "Yet, there is no evidence that the skilled artisan would have been led by anything…to modify…make an additional modification based on teachings of an IP communication in a cellular system".

The mobile communications enables the users to engage in a communication from any remote location using the mobile device.

Vilander discloses setting up a connection session between a wireless calling party and the wireless called party using the SIP protocol, e.g. col. 2 L59-67.

As set forth in the RFC 2543: SIP protocol, the protocol enables inviting the participants to join and/or engage in a session.

As such, it would have been obvious to a person of ordinary skilled in the art at the time the invention was to modify Liou, Dalrymple, Handley in view of Vilander in order to enable communications between the mobile calling party and the mobile called party.

One of ordinary skilled in the art would have been motivated because it would enabled users to participate in a communication session using the mobile devices, See also Dalrymple: col. 3 L50 to col. 4 L21, Vilander: col. 2 L59-67, col. 4 L60-67.

f. These allegations of obviousness by the Examiner amount to a classic case of impermissible hindsight…(The Brief, pg. 26).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Moreover, **the rationale supporting the combination can be found in KSR Ruling. See KSR International Co. v. Teleflex Inc.**, 550 U.S. ___,___, 82 USPQ2d 1385, 1395-97

(2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper "functional approach" to the determination of obviousness as laid down in Graham. The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit, and **MPEP 2143.** [EXEMPLARY RATIONALES:

Exemplary rationales that may support a conclusion of obviousness include:
(A) Combining prior art elements according to known methods to yield predictable results;
(B) Simple substitution of one known element for another to obtain predictable results;
(C) Use of known technique to improve similar devices (methods, or products) in the same way;
(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
(E) "Obvious to try" – choosing from a finite number of identified, predictable;
(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;
(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. See MPEP § 2143 for a discussion of the rationales listed above along with examples illustrating how the cited rationales may be used to support a finding of obviousness].

For example: In this case, rationale A, B, C, D and/or G applies.

Stated another way, the claims on the appeal are mere combination of prior art elements, which results in a predictable results such as inviting the guest users to participate or engage in a session, enabling the guest users to send data/instruction/requests during the session and enabling the wireless users to participate in the session in a wireless manner and/or enabling the users to participate in the session through mobile devices.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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